

REMARKS

In response to the various paragraphs of the Office Action, Applicants offer the following remarks:

(1) Response. The Office Action indicates that claims 1-30 have been cancelled and claims 31 and 32 have been added. Applicants believe that this is an error, as claims 1-31 have been cancelled and claims 32 and 33 have been added.

(2) Format. Pursuant to the Examiner's request, Applicants have now shown claims 32-33 in a proper format for a Reissue application. Claims 31-32 are both shown entirely underlined. These claims have not been amended.

The Office Action refers to an amendment filed August 30, 2002. Applicants believe that this is an error, as the only Amendment filed was on June 21, 2002 which cancelled claims 28-31 and added new claims 32-33.

(3) Concurrent Proceedings. The Examiner is already aware of the parent Reissue application and Divisional Reissue applications that are concurrently proceeding through the Patent Office with this Divisional Reissue application.

(4) Capacity to sign for corporation.

Applicants have now enclosed a better copy of an originally submitted Certificate Under 37 CFR 3.73 (b) in this Application. The title of the signer in the originally submitted Certificate is not clear. In the enclosed copy, the title is more clear. The stamp sets forth his name and title as "General Manager IP Development Center, Authorized Signing Officer". Page 1 of the Certificate sets forth that "The

undersigned is empowered to act on behalf of the assignee." Applicants request that the Office substitute the enclosed copy for the originally submitted copy.

(5)-(6) Declaration. A Substitute Declaration, updating the errors corrected, is enclosed, as requested by the Office. The Substitute Declaration is a copy of the Substitute Declaration submitted in the parent Reissue application, no. 09/588,364.

(7) Surrender of Patent. The original patent was surrendered to the Office in the copending Reissue application, no. 09/588,364, on November 22, 2002. As the original patent was lost, Applicants have submitted a communication in the copending (parent) Reissue application, no. 09/588,364, stating that the original patent had been lost (see enclosed copy of a Communication dated December 20, 2002).

(8)-(9) Double Patenting. The Office has rejected claims 32-33 because they claim the same invention as that of claims 1-12, 36-37 of copending Reissue application, serial no. 09/588,364. Applicants respectfully submit that claims 32-33 include features not found in claims 1-12, 36 and 37 of the copending Reissue application and, therefore, cannot be the same invention for the reasons set forth below.

Claim 32 includes the following features:

- a track of spiral shape; and
- a barcode pattern formed by a laser on the track.

Claim 33 includes the following features:

- forming a track of spiral shape on a substrate of the optical disk; and

- forming a barcode pattern by a laser on the track.

Claims 1-12, 36 and 37 of the copending Reissue application each includes features not found in either claim 32 or 33. In addition, claims 32 and 33 each includes features not found in any of claims 1-12, 36 and 37. Therefore, these sets of claims are not identical inventions, for the following reasons:

Claim 1 of the copending Reissue application includes at least two features not found in claim 32 or 33, namely "marking position detection means" and "position information output means." Moreover, claim 1 includes "marking forming means for applying at least one mark to the reflective film." Claim 32, on the other hand, includes "**a track of spiral shape**" and "**a barcode pattern formed by a laser on a track**". These features in bold are not found in claim 1. Claim 32 does not have identical subject matter with claim 1 and, thus, is not the "same invention" as claim 1. In addition, claim 33 is a method claim, whereas claim 1 is an apparatus claim. Therefore, claim 33 is not the "same invention" as claim 1.

Claims 2-11 of the copending Reissue application depend from claim 1 and include additional features that limit claim 1. Consequently, claim 32 or claim 33 cannot be the same invention as claims 2-11 for at least the same reasons set forth above.

Claim 12 of the copending Reissue application includes "laminating the disk and another disk together" and "trimming the reflective film to form at least one marking by a laser on the reflective film". Claim 33, on the other hand, does **not** include laminating two disks together, and includes "**forming a track of spiral shape**" and "**forming a barcode pattern by a laser on a track.**" These features in bold are not found in claim 12. Claim 33 is thus not the "same invention" as claim

12. In addition, claim 32 is an apparatus claim, whereas claim 12 is a method claim. Therefore, claim 32 cannot be the "same invention" as claim 12.

Claim 36 of the copending Reissue application includes "a data zone indicating data signals." Claim 32, on the other hand, includes "**a track of spiral shape**" and "a barcode pattern **formed by a laser** on a track." These features in bold are not found in claim 36. Claim 32 is thus not the "same invention" as claim 36. In addition, claim 33 is a method claim, whereas claim 36 is an apparatus claim. Therefore, claim 33 cannot be the "same invention" as claim 36.

Claim 37 of the copending Reissue application includes "forming...a data zone indicating data signals." Claim 33, on the other hand, includes "**forming a track of spiral shape**" and "forming a barcode pattern **by a laser** on a track." The features in bold are not found in claim 37. Claim 33 is thus not the "same invention" as claim 37. In addition, claim 32 is an apparatus claim, whereas claim 37 is a method claim. Therefore, claim 32 cannot be the "same invention" as claim 37.

Accordingly, Applicants respectfully submit that claims 32 or 33 of this application are not the same inventions (do not include the same subject matter) as any of claims 1-12, 36 and 37 of the copending Reissue application. Therefore, these sets of claims are not subject to a rejection in view of double patenting based on U.S.C. 101.

In the event that the Examiner rejects claims 32 and 33 in view of double patenting based on the obviousness kind (non-statutory), Applicants terminally disclaim a patent granted based on this application, and have thus enclosed a terminal disclaimer.

(10)-(11) Section 102 Rejection. The Office rejected claims 32 and 33 as being anticipated by Ikeda. Applicants submit that this rejection is overcome for the reasons set forth below.

Claim 32 includes the following features:

- a **track of spiral shape**
- a **barcode pattern formed by a laser on the track**.

Basis for forming a spiral track may be seen, for example, in FIG. 13A. Basis for forming a barcode pattern by a laser may be seen, for example, in FIG. 1 (819 a, b and d).

Ikeda, cited by the Examiner, discloses in FIG. 1, marks on disk 1. The marks contain pits (FIG. 2) indicating data signals. As understood by Applicants, Ikeda forms a reflective film on top of the pits (marks), so that the pits may be readable by an optical detector. Ikeda first forms the pits (marks) and then forms a reflective layer on top of the pits (marks). Ikeda does **not** form marks of a barcode pattern **by a laser**.

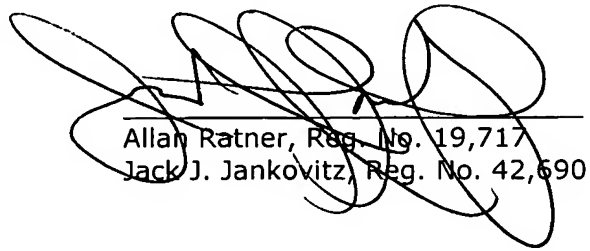
Furthermore, Ikeda does **not** suggest a barcode pattern formed by a laser on **a spiral track**. The area where Ikeda forms a barcode-like pattern does **not** have a **spiral track**. While Ikeda shows a circular barcode-like pattern, he does not show anything like a spiral track. A spiral track is generally formed continuously, without any interruptions. The area that includes the barcode-like pattern (FIG. 1 of Ikeda), however, shows no tracks between successive markings. The area appears to be without spiral tracks.

Although not the same, claim 33 includes features similar to claim 32 and, therefore, is not subject to rejection in view of Ikeda for the same reasons set forth for claim 32.

Reconsideration of claims 32 and 33 is respectfully requested.

Respectfully submitted,

RatnerPrestia



Allan Ratner, Reg. No. 19,717
Jack J. Jankovitz, Reg. No. 42,690

JJJ:kc

Enclosures: Substitute Declaration
Communication dated December 20, 2002
Terminal Disclaimer
Copy of Certificate Under 37 CFR 3.73 (b)

Dated: April 1, 2003

P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Assistant Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.